



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,108	06/02/2000	Neil A Willcocks	2280.2620	6805
5514 7590 07/18/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
PHAM, THIERRY L				
ART UNIT		PAPER NUMBER		
2625				
MAIL DATE		DELIVERY MODE		
07/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/587,108

**Applicant(s)**

WILLCOCKS ET AL.

**Examiner**

THIERRY L. PHAM

**Art Unit**

2625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-65 and 83-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-65, 83-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

- This action is responsive to the following communication: RCE filed on 5/27/2008.
- Claims 31-65, 83-97 are currently pending, wherein claims 93-97 are newly added; claims 1-30 & 66-82 have been canceled.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/27/2008 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-65, 83-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Over et al (US 6538767).

Regarding claim 31, Over discloses a system (system 1, fig. 2) for enabling consumer (users or customers, col. 6, lines 5-8) to submit a customizable image (receiving customizable image or personalized image from consumer's computer remotely via LAN, WAN, Internet, col. 6, lines 5-17) to be printed directly on a non-planar surface (non-planar surfaces including ornaments, baseball, basketball, cups, blocks, cylinders, eggs, and etc, col. 5, lines comprising:

- a computer (imaging system 20, fig. 2), adapted to communicated (via LAN, WAN, or Internet communication network, col. 6, lines 5-15) with consumer's computer and enable the consumer's computer to communicate image data via a network (customizable image or

personalized image from consumer's computer remotely via LAN, WAN, Internet, col. 6, lines 5-17); and

- an ink-jet printer (ink-jet printer system 10, fig. 1, col. 5, lines 35-36) adapted to receive the image data from the computer and print directly on a non-planar surface (non-planar surfaces, col. 5, lines 1-17) a high quality image having a resolution greater than about 200 dpi (at least 360 dpi, col. 11, lines 15-40) that corresponds to the received image data in the manufacture of personalized objects (non-planar objects with personalized message or image, col. 6, lines 1-17), *but Over does not specifically teach and/or suggest the object to be printed with personalized image is either a sugar shell candy or jellybean.*

Over's disclosure can be used to print on various types of objects and surfaces (e.g. spherical objects, semi-spherical objects, curve surfaces objects, non-linear surfaces, and such objects include ornaments, baseball, basketball, golf balls, tennis balls, soccer balls, footballs, eggs, baseball hats, cups, blocks, and cylinders, col. 5, lines 1-17), ***wherein both the objects and inks can also be "edible"*** (col. 3, lines 13-15, col. 5, lines 45-48, and col. 7, lines 13-17).

Since system as taught by Over is able to print customized/personalized images (col. 6, lines 5-17) on any objects (e.g. edible and non-edible objects, col. 5, lines 40-47) and any surfaces (planar and non-planar surfaces, col. 5, lines 2-17). Therefore, it would have been obvious to print customized/personalized image on an "edible" objects including ***sugar shell candy or jellybean.***

Regarding claim 32, Over further discloses a system according to Claim 31, wherein the network is the Internet (col. 6, lines 9-10). Over does not specifically teach and/or suggest a Web Browser runs on consumer computer adapted to send and receive Hypertext Markup Language (HTML) forms over the World Wide Web. Since system as taught by Over is implemented via using Internet and wherein Web Browser such as Internet Explorer or Netscape is widely available and well known installed on most consumer computer, therefore, it would have been obvious to include Web Browser on consumer/customer's computer that enable consumers/customers to send personalized image to manufacturer via using World Wide Web (Web Browser).

Regarding claim 33, Over further discloses a system according to Claim 31, wherein the network is a local area network (fig. 1).

Regarding claim 34, Over further teaches a system according to claim 31, wherein the ink-jet printer prints on the sugar shell or jellybean using a dispersed pigment food-grade ink (edible inks, col. 5, lines 1-49) to obtain a printed image having resolution greater than 200 dpi (col. 11, lines 25-40) even if printed using a single printhead and single pass printing.

Regarding claim 35, Kofman further discloses ink-jet printer is a drop-on-demand ink-jet printer (drop-on-demand ink-jet printer is well known and widely used in the print arts).

Regarding claim 36, Over further teaches wherein the printed image has a resolution between 300 and 1200 dpi (col. 11, lines 25-40).

Regarding claim 83, Over further teaches a system according to claim 31, further comprising a subsystem for holding (fig. 1, 9-10) the sugar shell candies or jellybean transiently in position and serially (the object may be mounted on a table that rotates the object to each successive position or may be mounted on an "assembly" that moves along a straight path between the print heads, col. 3, lines 19-24) transporting them past a printhead for printing.

Regarding claim 88, Over further teaches a system according to claim 31, wherein the customizable image is a personalized message (col. 6, lines 1-17).

Regarding claim 93, Over further teaches a system according to claim 31, further comprising an image processor adapted to process the image data and to allow the consumer to preview options (image preview 108 for allowing an operator to view the graphics that are to be applied to the objects, col. 12, lines 25-30, in addition, each consumer's computer includes a user interface display (e.g. monitor) that allows users/consumers to preview images and to adjust/modify (e.g. resize, cropping, color adjusting, and etc) the image before sending to the manufacturer) for decoration of said sugar shell candy or jellybean.

Regarding claims 37-65, and 84-87, 89-92, 94-97 recite limitations that are similar and in the same scope of invention as to those in claims 31-36, 83, and 88, and 93 above; therefore, claims 37-65, and 84-87, 89-92, 94-97 are rejected for the same rejection rationale/basis as described in claims 31-36, 83, and 88, and 93 above.

### ***Response to Arguments***

- Applicant's arguments with respect to claims 31-65, 83-92 have been considered but are moot in view of the new ground(s) of rejection.

Regarding to independent claims 31, 37, 43, 48, 54, and 60, the applicants argued the cited prior arts do not disclose a system controlled by a consumer.

In response, the examiner fully disagrees. Over clearly teaches wherein the personalized image can be scanned by the operator of the manufacturer (col. 5, lines 65-67) or personalized image can be received by the consumers (receiving customizable image or personalized image from consumer's computer remotely via LAN, WAN, Internet, col. 6, lines 5-17)

Regarding claims 83-87, the applicants argued the cited prior arts do not disclose a system whereby confectionery items are serially conveyed past a printhead.

In response, the examiner disagrees. Over clearly teaches a system wherein the object (edible and non-edible) is printed by plurality of print stations (see fig. 4). The object may be mounted on a table that rotates the object to each successive position or may be mounted on an "assembly" that moves along a straight path between the print heads, col. 3, lines 19-24.

Regarding the newly added claims 93-97, the applicants argued the cited prior arts do not disclose a system whereby consumers can interactively submit, select, preview and modify images to be printed on confectionery.

In response, the examiner disagrees. Limitations/features as cited in claims 93-97 does not indicate or include features of "interactively" submit, select, and modify images. It only includes features of "print preview options". Over clearly teaches an image preview 108 for

allowing an operator to view the graphics that are to be applied to the objects, col. 12, lines 25-30. In addition, each consumer's computer includes a user interface display (e.g. monitor) that allows users/consumers to preview images and to adjust/modify (e.g. resize, cropping, color adjusting, and etc) the image before sending to the manufacturer/producer.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THIERRY L. PHAM whose telephone number is (571)272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thierry L Pham/  
Art Unit 2625

/Edward L. Coles/  
Supervisory Patent Examiner, Art Unit 2625